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MS APPEAL BRIEF - PATENTS
PATENT
1982-0143P

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Before the Board of Appeals

Takeshi MISAWA

Appeal No.:

Appl. No.: 09/500,224

Group: 2615

Filed: February 8, 2000

Examiner: Y. K. AGGARWAL

Conf.: 2273

For: DIGITAL CAMERA AND METHOD OF RECYCLING DIGITAL
CAMERA

APPEAL BRIEF TRANSMITTAL FORM

MS APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

March 16, 2005

Sir:

Transmitted herewith is an Appeal Brief on behalf of the Appellants in connection with the above-identified application.

The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

A Notice of Appeal was filed on December 29, 2004.

Applicant claims small entity status in accordance with 37 C.F.R. § 1.27

The fee has been calculated as shown below:

- Extension of time fee pursuant to 37 C.F.R. §§ 1.17 and 1.136(a) – \$120.00.
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- Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment(s)

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BRIEF FOR APPELLANT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

March 16, 2005

Sir:

This appeal is from the decision of the Examiner dated April 5, 2004, finally rejecting claims 1-20, which are reproduced as an Appendix to this Brief.

The commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17 and 1.21 that may be required by this paper, and to credit any overpayment, to deposit account 02-2448.

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I. REAL PARTY IN INTEREST

The named inventors have assigned their rights to the invention that is disclosed in the application and any patent that may issue therefrom to Fuji Photo Film Co., LTD, as recorded in the Patent and Trademark Office at Reel 010559, Frame 0451.

II. RELATED APPEALS AND INTERFERENCES

To the best of the knowledge of the undersigned, there are no other appeals or interferences known to Appellant, the Appellant's representatives, or the above noted assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF THE CLAIMS

Claims 1-20 are currently pending in the application. Claims 1-20 are rejected and the subject of the appeal. Claims 1, 7, and 14 are independent claims.

IV. STATUS OF AMENDMENTS

A Response was filed October 1, 2004 that included amendments to claims 1, 2, 4, 7, 8, 10, 12, 14, 17 and 19. The amendments were entered in the issued advisory action dated December 2, 2004. No amendments have been made subsequent to the October 1, 2004 Response.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claims 1, 7 and 14 each are directed to the use of an infrared communication feature on a device, such as a digital camera. Particular features of the claims are directed to a covering for the infrared communication feature. The protective covering is provided over the infrared communication section when not in use to provide protection.

The use of infrared communication on various devices is known in the prior art. The infrared ports, from which the infrared data is sent, are located on the outer casing of the devices and left exposed to possible fingerprints, scratches, dust, etc. Unlike other communication means, infrared necessarily requires an exposed area to be able to transmit signals. If the covering of the infrared transmitter/receiver is impaired by being dirty or scratched, the signals sent/received may not accurately represent the data contained on the signals. Because of the unique nature of infrared, the prior art has left the infrared port exposed on cameras and other devices so that communication can occur, thus leaving the infrared port susceptible to damage.

The protective covering recited in the independent claims address the problems with an exposed infrared port. The protective covering can be made of a reusable elastic member that conforms to the outer contour of the device. For example, as illustrated in Figs. 1A, 1B and 2, a digital camera is shown with the protective covering 36 which covers the window 30 used for infrared

communication and charging terminals 32. The protective covering 36 is a reusable elastic film. See page 9, lines 3 to page 10, line 2.

In claims 1 and 7, a removable protecting means is recited. The removable protecting means is illustrated with respect to Figs. 1A and 1B as the protective film 36. The protective film 36 is described at least on page 9, lines 3-14 of the specification.

Another feature of each of the independent claims is the operation of the digital camera or other device resetting itself upon removal of the protective film and the transferring of the data stored in the device. When a user removes the protective covering, all the data stored in the device is transferred from the infrared port to an external device, such as a computer. This triggers a resetting feature that resets the device. The device is then returned to its original state and is ready to use again when the protective covering is placed back over the infrared port. See page 3, lines 12-17 and page 14, line 11 to page 15, line 4.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The final Office Action presents five grounds of rejection for review on Appeal.

1. Claims 1, 7, 12, 14, 19 and 21-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Oswal (U.S. Patent No. 6,181,883)
2. Claims 2, 4, 8, 10, 15 and 17 stand rejected under 35 U.S.C. § 103(a) as being anticipated by Oswal (U.S. Patent No. 6,181,883) in view of Etoh et al. (U.S. Patent No. 5,959,671)
3. Claims 3, 9 and 16 stand rejected under 35 U.S.C. § 103(a) as being anticipated by Oswal (U.S. Patent No. 6,181,883) in view of Ando (U.S. Patent No. 6,304,724)
4. Claims 5, 11 and 18 stand rejected under 35 U.S.C. § 103(a) as being anticipated by Oswal (U.S. Patent No. 6,181,883) in view of Hatori (JP Patent No. 410042231A)
5. Claims 6, 13 and 20 stand rejected under 35 U.S.C. § 103(a) as being anticipated by Oswal (U.S. Patent No. 6,181,883) in view of Hatori (JP Patent No. 410042231A) in further view of Norris (U.S. Patent No. 4,523,825)

VII. ARGUMENT

A. Claims 1, 7, 12, 14, 19 and 21-23 are not properly rejected under 35 U.S.C. § 102(e) in view of Oswal

According to MPEP §2131, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ...claims.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989). The elements must be arranged as required by the claims, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Oswal Fails to Teach all the Claimed Limitations

Description of Oswal

Oswal teaches a digital camera that includes a communication port that includes a RJ-11 or similar connector 72, and another communication port 74. See Fig. 5 of Oswal. The communication ports allows image data to uploaded to a computer or other device. Along with the communication ports 72 and 74, Oswal teaches an edge connector 78 that is covered by a hinge cover 76. The edge connector is used for connecting with a docking station and the transferring of information via the docking station. See column 8, lines 29-40.

In addition the camera may be designed to house a short length built-in communication cable for electrically and mechanically connecting to a computer. Also, the camera may be designed to implement a wireless communication, including RF, infrared, microwave, etc. See column 8, lines 45-50.

Independent Claim 1 and Dependent Claims 2-5

The method recited in claim 1 is explicit in describing a covering for an infrared communication section and also a resetting function based on the removal and replacement of the infrared communication cover. Specifically, claim 1 recites, *inter alia*,

“covering the infrared communication section portion of the digital camera with a removable protecting means which is removed at times when the image data is output, the protecting means substantially contouring to the outer surface of the communication section, wherein, after the protecting means is removed and the image data is taken out from the communication section, the communication section is once again covered by the protecting means, thereby resetting the infrared communication section.”

Oswal, to the contrary, teaches a hinge cover 76 for an edge connector 78. Oswal teaches that infrared communication can be implemented in the digital camera. However, appellant submit that Oswal does not teach covering the infrared communication section. The Examiner contends that the cover 76 in Oswal anticipates the claimed covering of the infrared communication section, recited in appellant's claim 1. Appellant respectfully submits that

feature 76 of Fig. 5 is a hinge cover, used to cover a pin connector or other type of electrical connector that is a direct or cable connector. The hinge cover does not cover an infrared communication section.

The Examiner alleges that teachings of infrared are provided in Oswal at column 8, lines 45-50. Appellant does not refute the fact that infrared communication by cameras is known in the art. At column 8, lines 45-50 Oswal states “the camera may also be designed with a wireless (infrared, RF, microwave, etc.) transmitter/receiver for exchanging image data with a suitably located host device.” Appellant respectfully submits that this statement does not teach anything beyond the use of infrared in a camera device. Significantly, it does not teach covering an infrared communication section, as claimed.

Simply stated, Oswal does not teach or suggest providing any type of protection covering means for an infrared transmitter/receiver. The only cover taught in Oswal is the hinge cover 76 that is used to cover pin connectors.

Further, since Oswal does not teach covering an infrared communication section, Oswal cannot teach resetting the infrared communication when the cover is removed to obtain the image data and the cover reapplied to the infrared communication section. Oswal’s lone statement regarding infrared communication is that it may be used in the digital camera. This statement does not describe the covering of the infrared communication device and the resetting function described above.

In view of the above, Appellant respectfully submits that the Examiner has failed to establish that Oswal teaches each and every feature of claim 1, as required under 35 U.S.C. §102. Appellant respectfully submits that dependent claims 2-5 are likewise patentable over Oswal for the above reasons.

Independent Claim 7 and Dependent Claims 8-13

Claim 7 is directed to a digital camera and also explicitly recites a removable protective means over an infrared communication section. Specifically, claim 7 recites, *inter alia*,

“an infrared communication section ... and a removable protecting means which covers the infrared communication section of the digital camera and is removed at times when the image data is output, thereby resetting the infrared communication section, the protecting means substantially contouring to the outer surface of the communication section.”

As with claim 1, claim 7 recites features that include a removable protective means for the infrared communication section and is contoured to the outer surface of the digital camera. A resetting operation is performed when the protecting means is removed and data output.

Appellant respectfully submits that the arguments presented above with respect to the removable protective means and the resetting operation , also apply to claim 7. As argued above, Oswal teaches a cover 76 that covers the edge connector 78. Oswal merely teaches the use of infrared communication is possible with the digital camera. Oswal doesn't even teach providing a cover

for the alternate communication ports 72 and 74, Oswal only teaches providing a cover for one connector, the edge connector 78. The Examiners interpretation of Oswal by applying the cover 76 as an infrared cover, is clearly erroneous and unfounded.

Further, Oswal cannot teach resetting of the infrared communication section with removal of the protecting means and the output of image data, because Oswal does not teach a protecting means for an infrared communication section.

Thus, Appellant respectfully submits that Oswal fails to teach each feature of Appellants claim 7 as required. Appellant respectfully submits that dependent claims 8-13 are patentable over Oswal for the above reasons.

Independent Claim 14 and Dependent Claims 15-20

Claim 14 is also directed to a digital camera and explicitly recites a removable protective cover for an infrared communication section. Specifically, claim 14 recites, *inter alia*,

“an infrared communication section ... and a removable protecting cover which covers the infrared communication section of the digital camera and is removed at times when the image data is output, thereby resetting the infrared communication section, the protecting cover substantially contouring to the outer surface of the communication section.”

Claim 14 recites features that include a protecting cover for the infrared communication and a resetting operation that is performed when the protecting cover is removed and data is output.

Appellant respectfully submits that the arguments presented above with respect to Oswal's lack of teaching a protective cover for an infrared port and as resetting operation, also apply to claim 14. Simply stated Oswal fails to teach the use of a protective cover for an infrared communication device. The cover 76 in Oswal cannot be said to correspond to an infrared protective covering as alleged by the Examiner. Further, a resetting operation is not performed in Oswal's digital camera. As recited in claim 14, a resetting of the infrared communication section is performed after the protective cover is removed and the image data is output. Oswal only teaches that infrared communication can be performed and nothing else.

Thus, Appellant respectfully submits that Oswal fails to teach every feature of claim 14 as required.

B. Claims 2, 4, 8, 10, 15 and 17 are not properly rejected under 35 U.S.C. § 103(a) as being anticipated by Oswal in view of Etoh et al.

Oswal fails to teach the all the features of the respective independent claims, as argued above. Further, Etoh does not teach the features of the independent claims asserted to be deficient in Oswal as argued above in detail. Indeed, Etoh is not applied by the Examiner to teach those features. Thus, the combination of Oswal and Etoh fail to teach each and every feature of the

dependent claims as required under 35 U.S.C § 103. Accordingly, the dependent claims are novel in view of the combination of Oswal and Etoh.

C. Claims 3, 9 and 16 are not properly rejected under 35 U.S.C. § 103(a) as being anticipated by Oswal in view of Ando

Oswal fails to teach the all the features of the respective independent claims, as argued above. Further, Ando does not teach the independent claims asserted to be deficient in Oswal as argued above in detail. Indeed, Ando is not applied by the Examiner to teach those features. Thus, the combination of Oswal and Ando fail to teach each and every feature of the dependent claims as required under 35 U.S.C § 103. Accordingly, the dependent claims are novel in view of the combination of Oswal and Ando.

D. Claims 5, 11 and 18 are not properly rejected under 35 U.S.C. § 103(a) as being anticipated by Oswal in view of Hatori

Oswal fails to teach the all the features of the respective independent claims, as argued above. Further, Hatori does not teach the independent claims asserted to be deficient in Oswal as argued above in detail. Indeed, Hatori is not applied by the Examiner to teach those features. Thus, the combination of Oswal and Hatori fail to teach each and every feature of the dependent claims as required under 35 U.S.C § 103. Accordingly, the dependent claims are novel in view of the combination of Oswal and Hatori.

E. Claims 6, 13 and 20 are not properly rejected under 35 U.S.C. § 103(a) as being anticipated by in view of Hatori in further view of Norris

Oswal fails to teach the all the features of the respective independent claims, as argued above. Further, Hatori and Norris do not teach the independent claims asserted to be deficient in Oswal as argued above in detail. Indeed, Hatori and Norris are not applied by the Examiner to teach those features. Thus, the combination of Oswal, Hatori and Norris fail to teach each and every feature of the dependent claims as required under 35 U.S.C § 103. Accordingly, the dependent claims are novel in view of the combination of Oswal, Hatori and Norris.

VIII. CONCLUSION

Based on the reasons set forth above, the rejections of claims 1-20 under 35 U.S.C. §102 should be REVERSED. As shown in the foregoing arguments, the claimed features of the present invention are not disclosed or suggested in the cited documents. Accordingly, reversal of the rejection is respectfully requested.

Appln. No.: 09/500,224

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. 1.16 or under 37 C.F.R. 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Appendix – ClaimsAppealed

APPENDIX – CLAIMS APPEALED

Claim 1.

A method of recycling a digital camera which includes an infrared communication section, comprising:

outputting image data from the infrared communication section to an external device; and

covering the infrared communication section portion of the digital camera with a removable protecting means which is removed at times when the image data is output, the protecting means substantially contouring to the outer surface of the communication section,

wherein, after the protecting means is removed and the image data is taken out from the communication section, the communication section is once again covered by the protecting means, thereby resetting the infrared communication section.

Claim 2.

A method of recycling a digital camera according to claim 1, wherein the protecting means covers the infrared communication section and charging terminals for charging a power source.

Claim 3.

Method of recycling a digital camera according to claim 1, wherein said protecting means is a sheet-shaped member which is elastic.

Claim 4.

A method of recycling a digital camera according to claim 1, wherein said protecting means is a protection film which wraps up the infrared communication section and the charging terminals.

Claim 5.

A method of recycling a digital camera according to claim 1, further comprising an indicating means for indicating that said protecting means was removed.

Claim 6.

Digital camera according to claim 5, wherein said indicating means is a "seal broken" mark which is exposed when the protecting means is removed.

Claim 7.

A digital camera comprising:
an infrared communication section which outputs image data to an external device, and

a removable protecting means which covers the communication section of the digital camera and is removed at times when the image data is output, thereby resetting the infrared communication section, the protecting means substantially contouring to the outer surface of the communication section.

Claim 8.

A digital camera according to claim 7, wherein the protecting means covers the infrared communication section and charging terminals for charging a power source.

Claim 9.

A digital camera according to claim 7, wherein said protecting means is a sheet-shaped member which is elastic.

Claim 10.

A digital camera according to claim 7, wherein said protecting means is a protection film which wraps up the infrared communication section and the charging terminals.

Claim 11.

A digital camera according to claim 7, further comprising indicating means for indicating that said protecting means was removed.

Claim 12.

A digital camera according to claim 7, wherein said infrared communication section is formed integrally with a body of the digital camera, and is a window whose transmission of data to and receipt of data from an external device is controlled by a CPU.

Claim 13.

A digital camera according to claim 11, wherein said indicating means is a "seal broken" mark which is exposed when the protecting means is removed.

Claim 14.

A digital camera comprising:
an infrared communication section which outputs image data to an external device, and
a removable protecting cover which covers the communication section and is removed at times when the image data is output, thereby resetting the communication section, the protecting cover substantially contouring to the outer surface of the communication section.

Claim 15.

A digital camera according to claim 14, wherein the protecting cover covers the infrared communication section and charging terminals for charging a power source.

Claim 16.

A digital camera according to claim 14, wherein said protecting cover is a sheet-shaped member which is elastic.

Claim 17.

A digital camera according to claim 14, wherein said protecting cover is a protection film which wraps up the infrared communication section and the charging terminals.

Claim 18.

A digital camera according to claim 14, further comprising indicating means for indicating that said protecting means was removed.

Claim 19.

A digital camera according to claim 14, wherein said infrared communication section is formed integrally with a body of the digital camera,

and is a window whose transmission of data to and receipt of data from an external device is controlled by a CPU.

Claim 20.

A digital camera according to claim 18, wherein said indicating means is a "seal broken" mark which is exposed when the protecting means is removed.